REMARKS

Amendments to the Specification

The Specification has been amended to more correctly present the priority claim. Specifically, the Specification has been amended to more properly indicate the filing date of U.S. Application Number 08/913,290 as May 15, 1996, the filing date of PCT Application Number IB96/00461 of which U.S. Application Number 08/913,290 is the National Stage filing.

Amendments to the Claims

Claims 1, 12, and 22 have been amended to correct typographic / grammatical errors. Support can be found, for example, in paragraph **[0074]** of the published specification US 2006-0159688 A1. Applicants submit that no new matter is introduced into these claims, and the amendments do not narrow the scope of the claims.

Election in Reply to Restriction

According to the Examiner, the claims are directed to seven different inventions:

Group I: Claims 1, 3, 4 in part, 5, 6, 9-11, and 26-30, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of an antibody that binds to a xenotypic antibody. If Group I is elected claim 4 will be examined to extent this claim reads on the CA125 antigen;

Group II: Claims 1, 3, 4, in part, 5, 6, 9-11, and 26-30, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of an antibody that binds to a xenotypic antibody. If Group II is elected claim 4 will be examined to the extent this claim reads on the MUC-1 antigen;

Group III: Claims 1, 3, 4 in part, 5, 6, 9-11, and 26-30, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of an antibody that binds to a xenotypic antibody. If Group III is elected claim 4

will be examined to the extent this claim reads on the prostate specific Ag;

Group IV Claims 12-14, 15 in part, 16, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of an anti-idiotypic antibody that binds to a xenotypic antibody. If Group IV is elected claim 15 will be examined to the extent this claim reads on the CA125 antigen;

Group V Claims 12-14, 15 in part, 16, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of an anti-idiotypic antibody that binds to a xenotypic antibody. If Group V is elected claim 15 will be examined to the extent this claims reads on the MUC-1 antigen;

Group VI Claims 12-14, 15 in part, 16, drawn to a method of diagnosing the efficacy of an antibody mediated immunotherapy by measuring the level of an anti-idiotypic antibody that binds to a xenotypic antibody. If Group VI is elected claim 15 will be examined to the extent this claim reads on the prostate specific antigen;

Group VII Claims 22-25, drawn to a method of diagnosing the efficacy of antibody mediated immunotherapy by measuring the level of a T cell response.

Applicants hereby elect Group VII (Claims 22-25), *with traverse*. Applicants traverse the Restriction Requirement, because there is no significant search burden on the Examiner to search all Groups at once.

Specifically, elected Group VII and the non-elected Groups I – VI are all directed to methods of determining the efficacy of xenotypic antibody-mediated immunotherapy, with one of the differences being the end point being measured – T-cell response or antibody production. Thus all groups share common technical features that would facilitate searching all Groups at once without imposing additional serious burden on the Examiner. Accordingly, reconsideration and withdrawal of the Restriction Requirement are respectfully requested.

With respect to the non-elected Groups, Applicants submit that Groups I – III comprise the same claims, differing only with respect to the antigens recited in the Markush group in dependent Claim 4. Claims 1, 3, 5, 6, 9-11, and 26-30 are all generic with respect to antigen specificity of the xenotypic antibody. Had Applicants not presented dependent Claim 4, there would be no basis for restricting "Groups I – III," because the independent Claim 1 does not recite specific antigens. Thus it is inappropriate for the Examiner to restrict the claimed invention to an un-recited *species* antigen in a *genus* claim, because doing so amounts to using Restriction Requirement to limit the scope of independent claims that have not yet been examined on merits. Applicants note that the statutory basis for restriction practice arises under 35 U.S.C. § 121, which authorizes the patent office to require that each patent application be limited to a single invention. However, there is no basis in the statute or the rules (37 C.F.R. §§ 1.141 and 1.142) for the patent office to eliminate inventions from consideration entirely. A genus invention is as much an invention as each species. Thus, when the Examiner enumerates the various inventions that Applicants are requested to choose between, examiner is not authorized to omit the generic inventions.

Accordingly, these claims should not be restricted based on the antigen specificity of the xenotypic antibody as suggested by the Examiner. At most, the Examiner might issue an election of Markush species with respect to the three recited antigen species in Claim 4. In this case, pursuant to MPEP 803.02, "[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." Applicants submit that such is the case in Groups I - III. Particularly, since only three species are enumerated, all species can be examined simultaneously without significant additional burden on the Examiner. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

The same argument applies to the Restriction between Groups IV – VI. For example, Claims 12-14 and 15 are generic with respect to antigen specificity of the xenotypic antibody.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the Restriction between the elected and non-elected groups, and particularly with regard to restriction between Groups I – III and between Groups IV – VI.

Applicants submit that no species election is required because Group VII is elected.

CONCLUSION

Applicant believes no fee is due with this response other than the fee for the extension submitted concurrently. However, if any other fee is due, please charge our Deposit Account No. **18-1945**, from which the undersigned is authorized to draw, under Order No. **AREX-P03-005**.

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Respectfully submitted,

By _____

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